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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

THANH, LOAN H

ART UNIT

PAPER NUMBER

3763

9

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/766,910

Applicant(s)

HOCHMAN ET AL.

Examiner

LoAn H. Thanh

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Inventorship***

The request to correct the inventorship of this nonprovisional application under 37 CFR 1.48(a) is deficient because:

An oath or declaration by each actual inventor or inventors listing the entire inventive entity has not been submitted.

It lacks the required fee under 37 CFR 1.17(i).

The statement of facts by an inventor or inventors to be added or deleted does not explicitly state that the inventorship error occurred without deceptive intent on his or her part or cannot be construed to so state.

A 37 CFR 3.73(b) submission has not been received to support action by the assignee.

It lacks the written consent of any assignee of one of the originally named inventors.

### ***Information Disclosure Statement***

The information disclosure statement filed 5/7/01 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because MU 7502580-9 has not been translated. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the switch (claims 14-16) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

Reference numeral "58 " has been designated as both slot and top surface". See page 8, line 11 and page 9, line 2.

Reference numeral "95A" and "96" has been designated as both finger pad. See page 8, line 32 and page 9, line 1-2.

Applicant is requested to update the status of the application which priority is claimed.

Appropriate correction is required.

### ***Claim Objections***

Claim 10 is objected to because of the following informalities: "10.." should be "10.". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the piston" in 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "said tube" in line1. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recite the limitation "said piston" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recite the limitation "said piston" in line 2,3. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recite the limitation "said piston" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recite the limitation "said piston" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recite the limitation "said syringe" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 is vague and indefinite because it is unclear whether ON1, ON2 , OFF1 And OFF2 are in addition to the ON and OFF positions of claim 1.

Claim 12 is vague and indefinite because it is unclear what is intended by  
"between said two extremes in accordance with a hysteresis curve."

Claims 14-16 recite the limitation "said switch" in line 1. There is insufficient  
antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that  
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,4,10 rejected under 35 U.S.C. 102(e) as being anticipated by  
Rondelet et al. ( U.S. Patent No. 5,25,967).

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Rondelet et al. teach an injection system having a container/syringe, a pump, and a controller/computer which operates the pump and is adapted to move the plunger. With respect to claim 10, a selector is inherent in that it is the on and off switch such as power button. With respect to the functional language, it is the Examiner's position that the claims are directed to a device claim and as such there are no structurally distinguishing features which would differentiate the claims from the prior art of record. Further, the device is capable of functioning as claimed.

Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Spinello ( U.S. Patent No. 5,180,371).

Spinello disclose an injection system comprising a container/syringe, a pump, a controller/ microcontroller, a piston for injecting or aspirating , and a selector/switch which operates in different modes. See columns 3, 5-6,7 and 10. See figures 5-8. With respect to the functional language, it is the Examiner's position that the claims are directed to a device claim and as such there are no structurally distinguishing features which would differentiate the claims from the prior art of record. Further, the device is capable of functioning as claimed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (703) 305-0038. The examiner can normally be reached on Monday to alternating Fridays (7:00 am-4:30 pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to read 'LoAn H. Thanh', with a stylized flourish at the end.

LoAn H. Thanh  
Primary Examiner  
Art Unit 3763

LT